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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/242,525	02/17/99	SATO	S 11301-1480

GEORGE M THOMAS  
THOMAS KAYDEN HORSTEMEYER & RISLEY  
100 GALLERIA PARKWAY NW  
SUITE 1500  
ATLANTA GA 30339-5948

IM62/0719

EXAMINER	
SERGENT, R	
ART UNIT	PAPER NUMBER
1711	
DATE MAILED:	
07/19/00	

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. 09/242,525	Applicant(s) Sato et al.
	Examiner Rabon Sergent	Group Art Unit 1711

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- Claim(s) 1-45 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-17, 19, and 21-45 is/are rejected.
- Claim(s) 18 and 20 is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.
  - received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_.
- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. It is requested that applicants supply the months of publication of the "Other Documents" cited on the information disclosure statement of February 17, 1999.

Furthermore, applicants have failed to comply with the requirements set forth within 37 CFR 1.98 (a)(3) with respect to JP 8-53528, JP 5-505845, JP 6-500584, JP 51-73561, JP 63-68625, JP 2-99579, JP 2-102287, JP 3-140388 and, JP 3-281682. Their listing within the International Search Report is insufficient to satisfy the requirement.

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

3. Claims 18 and 20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

4. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears that claim 28 should depend from claim 27.

5. Claims 1-17, 19 and 21-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' Markush groups are improper, because the groups must be specified in the alternative. For example, the last species for the group (I) Markush group of claim 1 should be

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preceded by "or" rather than "and". The groups are improper for the specified group species and compounds.

Furthermore, it is unclear how instances of "and/or" and occurrences of "and" used with "or" in the same phrase are to be interpreted. See line 5 of claim 2 or lines 3 and 4 of claim 10 or lines 3-5 of claim 12, for example.

6. Claims 1-9, 27-36 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of "can" within the claims renders them indefinite, because it is unclear if or to what extent the language denoted by "can" is a definitive or non-optional limitation.

7. Claims 1-12, 14-17, 19, 21-36 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have used the language, "simultaneously or sequentially", throughout the claims; however, it is unclear what is meant by the language. It is not clear what sequence of events the language pertains to.

8. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is unclear how compound (p) has 0.2 or more active hydrogen atoms. Clarification is required.

9. Claims 14, 15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

When compounds (t-1), (u-1), or (x-1) are selected, the claims are rendered indefinite, because step (1) of each claim is not required.

10. Claims 16, 21, 22, 27-30, 37 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear that the products I, N, R and V of the second step include reaction schemes wherein the zircoaluminate derivatives are utilized. The confusion stems from the way in which the products are defined within the first steps.

11. Claims 2-17, 19 and 21-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' claims are replete with terms which lack antecedent basis. Applicants' independent claims make numerous references to species defined within other independent claims. This is impermissible. Each set of claims must clearly provide adequate antecedence solely from within the set. Applicants' lack of antecedence issues are so extreme that they preclude further

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search and consideration of the prior art. For example, independent claim 12 refers to "said compound (a-5)", "said compound (a-2)", "said compound (q)", "said compound (r)", "said compound (i)", "said compound (l)", "said compound (m)", and "the product B"; however, none of these compounds has been defined in claim 12.

12. In view of the severity of the 35 U.S.C. 112 issues and the cited prior art issues of paragraph 1, thorough search and consideration of the prior art was deemed to be unduly burdensome at the time of this examination.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent/amc

7-18-00

*Rabon Sergent*  
**RABON SERGENT  
PRIMARY EXAMINER**